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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,753	02/28/2002	Toshihito Tsuga	TI-31620	8409

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EXAMINER

KORNAKOV, MICHAEL

ART UNIT PAPER NUMBER

1746

DATE MAILED: 10/27/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/085,753

Applicant(s)

TSUGA ET AL.

Examiner

Michael Kornakov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7 and 8 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☒ Claim(s) 1-9 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-8, drawn to a method for removing particles on semiconductor wafers, classified in class 134, subclass 1.3.
 - II. Claim 9, drawn to a device for removing particles on semiconductor wafers, classified in class 134, subclass 56R.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group I and Group II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be utilized for forming ornamental articles by wet etching.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

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5. During a telephone conversation with Ms. J. Garner on 10/22/2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-8.

Affirmation of this election must be made by applicant in replying to this Office action.

Claim 9 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1,3 and 7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,2,3,5 and 6 of

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compending Application No. 10/085725. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1,2,3,5 and 6 of compending Application No. 10/085725 recite a method of removing particles on semiconductor wafers comprising the steps of immersing them in a cleaning solution consisting of ultra-pure water containing a prescribed quantity of ozone, immersing them in a cleaning solution consisting of HF mixed solution and immersing them in a cleaning solution containing ultra-pure water with prescribed quantity of hydrogen, which is in the same range (0.3 ppm to 0.8 ppm) as instantly claimed. Therefore, the instant claims 1,3 and 7 are obvious variances of claims 1,2,3,5 and 6 of compending Application No. 10/085725.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Specification

9. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Claim 4 recites the step of performing a **fifth cleaning process** in which semiconductor wafers are cleaned by immersing them in a fifth cleaning solution consisting of ultra-pure water, before semiconductor wafers are cleaned in a forth cleaning solution, consisting of HF mixed solution. However, the instant specification lacks the step, described by claim 4. Appropriate correction is required.

Claim Objections

10. Claim 6 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 6 depends on claim 1 and recites that the first cleaning solution contains hydrochloric acid. However, claim 1 recites the step of performing a first cleaning process, wherein a first cleaning solution **consists of** ultra-pure water containing a prescribed quantity of ozone.

The transitional phrase "consisting of" excludes any **element, step, or ingredient** not specified in the claim. **A claim, which depends from a claim, which "consists of" the recited elements or steps cannot add an element or step**, consult *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948). Applicant is required to cancel the claim, or amend the claim to place it in proper dependent form, or rewrite the claim in independent form. Accordingly, claim 6 in its present form has not been treated on the merits.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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12. Claims 1, 3, 5 and 7 are rejected under 35 U.S.C. 102(a) or 102(e) as being anticipated by Matsuno et al (US 2001/0009155).

Matsuno teaches a method for removal of fine particles, existing on semiconductor substrate, by treating the said substrate with ozone water, which has been prepared by dissolving an ozone containing gas in ultra-pure water (reads on the "first cleaning process", as instantly claimed); and treating the said substrate with hydrogen water, which has been prepared by dissolving a hydrogen containing gas in ultra-pure water (reads on the "second cleaning process", as instantly claimed), wherein the treatment with hydrogen water is enhanced by applying ultrasonic waves (page 12, claim 1; page 4, paragraph 0046). Matsuno teaches the preferable concentration of ozone in ozone water as being 10 ppm, the preferable concentration of hydrogen in hydrogen water as being 0.5 ppm, which corresponds to the limitations of the instant claims 5 and 7. Matsuno also teaches treating the substrate with HF-containing water (reads on the "fourth cleaning process", as instantly recited in claim 3) after the step in which the substrate is treated with said ozone water, said hydrogen water. Matsuno specifically indicates that his cleaning method can be realized utilizing soaking treatments of substrate in ozone water and hydrogen water (page 10, paragraph 0087) and therefore the step of immersing substrate in respective cleaning solution is inherent in Matsuno's teaching.

Thus, all the limitations of instant claims 1, 3, 5, and 7 are explicitly or inherently met by Matsuno et al.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. Claims 2, 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuno et al (US 2001/0009155).

Matsuno does not specifically indicate the steps of cleaning substrate with ultra-pure water after treating the substrate with ozone water, as per the instant claim 2 and after treating the substrate with hydrogen water, as per the instant claim 4. However, Matsuno provides clear motivation to implement such steps by stating that after cleaning the substrate is rinsed with ultra-pure water as needed (page 4, paragraph 0050). Therefore, one skilled in the art, motivated by Matsuno's statement, would have found it obvious to rinse semiconductor substrate with ultra-pure after each treatment step of Matsuno in order to prevent redeposition of fine particles and inhibit activity of the particular treatment solution.

While teaching soaking treatments of substrate in ozone water and hydrogen water, Matsuno remains silent about prescribed time for such treatments. It is noticed here, that durations of substrate treatment in ozone water and in hydrogen water are result effective parameters, because they affect the level of removal of respective fine particles and therefore the cleanness of substrate surfaces. However, discovery of optimum value of result effective variables in known process is ordinarily within the skill in the art and would have been obvious, consult *In re Boesch* and *Slaney* 205 USPQ 215 (CCPA 1980).

17. Applicant should note that additional prior art cited in PTOL-892 shows general state of the art.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Kornakov whose telephone number is (703) 305-0400. The examiner can normally be reached on 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (703) 308-4333. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 2450.

M. Kornakov

Michael Kornakov
Examiner
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